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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,248	09/17/2003	Michael Adam	51082/TJD/M881	1126
23363	7590	10/06/2005	EXAMINER	
CHRISTIE, PARKER & HALE, LLP			HOFFMAN, MARY C	
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PASADENA, CA 91109-7068			PAPER NUMBER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/667,248	Applicant(s) ADAM, MICHAEL	
	Examiner Mary Hoffman	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 2-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 10-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>9-22-05</u> |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/08/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention:

- A. Fig. 1-3
- B. Fig. 4-7
- C. Fig. 8-12

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 10 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

During a telephone conversation with Mr. Thomas Daly on 9/29/2005 a provisional election was made with traverse to prosecute the invention of Species C, Figs. 8-12, claims 1 and 10-17. However, the examiner finds that claim 10 is not readable on Species C because it the clamping member does not have a smaller length than the distance between two sequential transverse bores in the nail. Furthermore, applicant uses reference number (61) in the claim to denote the clamping member, and Species C does not possess a feature labeled as reference number (61). Affirmation of this election must be made by applicant in replying to this Office action. Claims 2-10 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

The abstract of the disclosure is objected to because it includes phrases that can be implied, e.g. "the invention relates to," and these phrases should be avoided.

Furthermore, the abstract is in claim format rather than narrative form.

Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," "the invention relates to," etc.

The disclosure is objected to because of the following informalities:

The sections of the specification are not preceded by their proper respective headings, e.g. "Title of the Invention," "Background of the Invention," "Brief Summary of the Invention," etc.

Furthermore, on page 11 of the specification, "nail 1" should be --nail 11--.

Appropriate correction is required.

Claim Objections

Claims 1 and 10-17 are objected to because of the following informalities:

In claim 1, line 4, "the nail" should be changed to --the at least one nail--. In line 5, "the screw" should be changed to --the at least one screw--. In line 6, "the nail" should be changed to --the at least one nail--. In lines 8-9, "the nail" should be changed to --the at least one nail--. In line 10, "the nail" should be changed to --the at least one nail--. In line 10, "the screw" should be changed to --the at least one screw--. In line 11, "the nail" should be changed to --the at least one nail--. In line 12, "the clamping member" should be changed to --the at least one clamping member--. In line 14, "the clamping member" should be changed to --the at least one clamping member--.

In claim 11, line 5, "the screw" should be changed to --the at least one screw--. In line 6, "the clamping member" should be changed to --the at least one clamping member--.

In claim 12, line 2, "the clamping member" should be changed to --the at least one clamping member--. In line 4, "the nail" should be changed to --the at least one nail--. In line 5, "the screw" should be changed to --the at least one screw--. In line 6, "the nail" should be changed to --the at least one nail--.

In claim 13, line 4, "the clamping member" should be changed to --the at least one clamping member--. In line 5, "the nail" should be changed to --the at least one nail-- and "the clamping member" should be changed to --the at least one clamping member--.

In claim 14, line 1, "the clamping member" should be changed to --the at least one clamping member--. In line 5, "the nail" should be changed to --the at least one nail--.

In claim 15, line 2, "the clamping member" should be changed to --the at least one clamping member--.

In claim 16, line 3, "the clamping member" should be changed to --the at least one clamping member--. In line 5, "the nail" should be changed to --the at least one nail--.

In claim 17, line 5, "the nail" should be changed to --the at least one nail--. In line 5, "its longitudinal bore" should be changed to --the longitudinal bore--. In line 6, "the clamping member" should be changed to --the at least one clamping member--. In line 7, "the nail" should be changed to --the at least one nail--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 recites the limitation "the orientation and the position of the screw" in line 5. There is insufficient antecedent basis for this limitation in the claim. Furthermore, there is insufficient antecedent basis for "the inner wall of the nail" and "the displacement of the clamping member" in lines 12 and 13-14, respectively.

Claim 11 recites the limitation "the side of the screw" in line 3. There is insufficient antecedent basis for this limitation in the claim. Furthermore, there is insufficient antecedent basis for "the displacement device" in line 4

Claim 16 recites the limitation "the displacement" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 17 recites the limitations " the outside" and "the side wall" in line 4-5. There is insufficient antecedent basis for this limitation in the claim. Furthermore, there is insufficient antecedent basis for "its starting position" in lines 6-7.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 11-17 rejected under 35 U.S.C. 102(b) as being anticipated by Sohngen (U.S. Patent No. 6,921,400).

Sohngen teaches a bone fixing system comprising at least one nail and at least one screw, which can be guided through a transverse bore formed in the nail (see FIG. 7). The orientation and the position of the screw with respect to the longitudinal axis of the nail can be defined (col. 4, lines 40-53). There is at least one clamping member (FIG. 7, ref. #50) that can be introduced into a longitudinal bore of the nail (FIG. 7, ref. #55). The clamping member is axially adjustable in the longitudinal bore relative to the nail, with the screw guided through the transverse bore the nail being able to be clamped between the clamping member and the inner wall of the nail bounding the transverse bore (FIG. 7, ref. #56) by the displacement of the clamping

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member. A section of the clamping member is disposed on the side of the screw remote from the displacement device (FIG. 7, ref. #65) can be moved against the screw by means of a displacement device by pulling on the clamping member. The clamping member is freely movable in the axial direction of the longitudinal bore of the nail and has at least one passage for the screw (FIG. 7, ref. #54) which can be aligned with the transverse bore of the nail. The clamping member is made in a sleeve shape. The displacement device includes a drawing screw (FIG. 7, ref. #65) that cooperates with a thread section of the clamping member (FIG. 7, ref. #57) and is supported at the nail for the drawing of the clamping member in the axial direction. The clamping member can have a plurality of passages (see FIG. 8) which are spaced apart from one another in the axial direction and can each be aligned with a transverse bore of the nail. The clamping member can be deformed in the axial direction by means of the displacement device. There can be a plurality of screws (see FIG. 9), wherein the clamping member can be deformed such that the plurality of screws spaced apart from one another in the axial direction of the nail can each be clamped between the clamping member and the inner wall of the nail bounding the respective transverse bore by the displacement device.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sohngen in view of Stauch et al (U.S. Patent No. 6,416,516).

Sohngen teaches the claimed invention except for a securing screw which can be moved from the outside through the side wall of the nail into its longitudinal bore and by which the clamping member can fixed starting position relative to the nail displacement device.

In the same field of endeavor, Stauch discloses using a threaded pin (see FIG. 2a) as a securing element which passes radially through the outside element of the intramedullary nail in order to secure and clamp the inside plugging device.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the device of Sohngen incorporating the teachings of Stauch in order to provide a means of securing against removal during operation and to prevent axial movement of the clamping member.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see attached PTO-892 for art cited of interest.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 8:30-5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCH



EDUARDO C. ROBERT
PRIMARY EXAMINER